

Notice of Allowability

Application No.

10/628,394

Examiner

Robert Shiao

Applicant(s)

MATSUMURA ET AL.

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to responses filed on August 26, 2005.
2. ☒ The allowed claim(s) is/are 1-3, 7-9, and 13-26, now are 1-20.
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date 07/05/05
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413),
Paper No./Mail Date _____.
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____.



DETAILED ACTION

1. This application claims benefit of the foreign application:

JAPAN 222149/2002 with a filing date 07/30/2002.

2. Amendment of claim 1, cancellation of claims 4-6, and 10-12, and addition of claims 15-26 in the amendment filed on August 26, 2005, is acknowledged. Since the newly added claims 15-26 are commensurate with the scope of the invention, therefore, claims 1-3, 7-9, and 13-26 are prosecuted in the case.

Responses to Amendment/Arguments

3. Applicant's arguments regarding rejection of claims 1-3, and 7-9 under 35 U.S.C. 112, first paragraph, filed on July 05, 2005, have been fully considered and they are persuasive. Therefore, rejection of claims 1-3, and 7-9 under 35 U.S.C. 112, first paragraph, is withdrawn herein. Since claims 4-6, and 10-12 have been cancelled, therefore, rejection of claims 4-6, and 10-12 under 35 U.S.C. 112, first paragraph, is obviated herein.

4. Rejection of claims 1-3, and 7-9 under 35 U.S.C. 112, second paragraph, has been overcome in the amendment filed on July 05, 2005. Since claims 4-6, and 10-12 have been cancelled, therefore, rejection of claims 4-6, and 10-12 under 35 U.S.C. 112, second paragraph, is obviated herein.

5. Applicant's arguments regarding rejection of claims 1-3, and 7-9 under 35 U.S.C. 103(a) over Fuchs's US 6,784,311, filed on July 05, 2005, have been fully considered,

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and they are persuasive. The instant processes are operated without using chromatography to obtain instant optically active compounds of formula (2). Therefore, rejection of claims 1-3, and 7-9 under 35 U.S.C. 103(a), is withdrawn herein. Since claims 4-6, and 10-12 have been cancelled, therefore, rejection of claims 4-6, and 10-12 under 35 U.S.C. 103(a), is obviated herein.

EXAMINER'S AMENDMENT

6. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee. Authorization for this examiner's amendment was given in a telephone interview with Warren M. Cheek on August 29, 2005. The application has been amended as follows:

In claim 1, line 6, after "a substituted aryl group". Insert

--thiophene,--

In claim 25, line 3, after "(R)-3-amino-3-", delete "thiopen", and insert

--thiophen--

Reasons for Allowance

7. The following is an examiner's statement of reasons for allowance:

Claim Claims 1-3, 7-9, and 13-26 are neither anticipated nor rendered obvious over the art of record, and therefore are allowable. This invention relates to method for

producing an optically active beta-amino acid. The closest reference is Fuchs's US 6,784,311, discloses method of producing 3-aminoalkanoic acid esters. The difference between Fuchs's' 311 and instant claimed processes is that the instant processes are not found in Fuchs's' processes. Suggestion for modification of above record to obtain the instant claimed processes has not been found. Claims 1-3, 7-9, and 13-26 are allowed.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusions

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Shiao whose telephone number is (571) 272-0707. The examiner can normally be reached on 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information

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for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

you have questions on access to the Private PAIR system, contact the Electronic

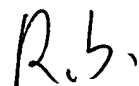
Business Center (EBC) at 866-217-9197 (toll-free).



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August 29, 2005